

## REMARKS

Claims 1-9 are pending in the present application. Claim 1 has been amended, no claims have been canceled, Claims 8 and 9 have been withdrawn, and Claims 10 and 11 have been added, leaving Claims 1-7 and 10-11 for consideration upon entry of the present Amendment.

Claim 1 has been amended to limit pencil hardness of the urethane-modified polyester resin composition to H as measured according to National Coil Coating Association (NCCA) standard II-12, and processability to 2T according to NCCA II-19. Support for this amendment can be found at least in the Specification on p. 12, Table 4, on p. 13, lines 3-6, and on p. 3, lines 19-20. No new matter has been introduced by these amendments.

New Claims 10 and 11 have been added to further claim the invention. Support for new Claim 10 can be found at least on p. 12 in Table 4, on p. 12, line 6 and p. 13, line 1, and in the Examples on p. 8, line 20 to p. 9, line 8 (Table 1). Support for Claim 11 can be found at least in Claim 1, and in the Examples on p. 8, line 20 to p. 9, line 8 (Table 1). No new matter has been introduced by these amendments.

Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

### Examiner's Constructive Election of Claims and Withdrawal of Nonelected Claims

Applicants acknowledge the constructive election of Claims 1-7 and withdrawal of Claims 8 and 9 by the Examiner, and affirm that the Examiner's election is made without traverse on the part of Applicants. Applicants wish to note that Applicants in foregoing traversal of the restriction of the claims preserve the future right to pursue the withdrawn claims, without prejudice.

### Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that there is no discussion of H values for the urethane-modified polyester resin composition system besides that in the

examples of the specification, and that the processability range of 2T is not supported in the specification. Accordingly, Claim 1 has been amended to remove the phrase "or harder" to limit the testable pencil hardness of the urethane-modified polyester resin composition to a value of H according to NCCA standard II-12, as supported on p. 13, lines 3-6 of the specification and as exemplified in Table 4 on p. 12. In addition, Claim 1 has been amended to remove the phrase "or lower" to thereby limit the processability to 2T according to the Specification on p. 12, Table 4, and on p. 3, lines 19-20 and is appropriately supported as described above.

Regarding the Examiner's statement that one cannot extrapolate properties from the examples for the purpose of supporting the claims, the application as a whole and the Examples in particular teach this aspect of the invention (i.e., pencil hardness and processability). "[M]atter added that makes explicit that which was implicit, inherent, or intrinsic in the original disclosure is not new matter and is permitted". 35 U.S.C. § 132. Furthermore, "conformation of one part of the disclosure to another portion thereof is clearly permissible." 37 C.F. R. § 1.117. Since Applicants have disclosed Examples wherein the improvement in pencil hardness and/or processability are an inherent feature of the examples, Applicants are permitted to later amend the Application to recite the inherent feature without introducing new matter. *In re Smythe and Shamos*, 178 U.S.P.Q. 279, 285-286 (C.C.P.A. 1973). The pencil hardness and processability of the urethane-modified polyester resin composition as claimed in Claim 1 and its dependents is therefore not new matter and can be introduced, and clearly show that Applicants had possession of these aspects of the invention at the time the application was filed.

Thus, no new matter was introduced by these amendments, and applicants were in possession of the invention as claimed. Accordingly, the claims should now be allowable to the Applicant. Reconsideration and allowance are therefore respectfully requested.

#### Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-7 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by United States Patent No. 4,452,924 ("Radovich"). Applicants respectfully traverse this rejection.

Radovich discloses flexible polyurethane foams having significantly enhanced load bearing properties. Abstract. The polyurethane foams are prepared from organic polyisocyanates and coupled polyol. Col. 1, lines 51-53. The coupled polyol can include a polyester. Col. 2, line 4.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

As noted in the Response file September 5, 2006 to the Office Action dated June 5, 2006 and as reproduced below, Radovich discloses, as a desired property of the flexible polyurethane foam, that the foam has significantly improved load bearing properties as measured using ASTM D 3574-81. Radovich, however, does not teach or disclose the pencil hardness or processability limitations of amended instant claim 1, and therefore does not disclose all elements of the amended instant claim. “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the \*\*\* claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Radovich simply fails to teach or disclose these properties, and moreover, teaches that the composition as disclosed in Radovich provides a completely different, non-equivalent set of properties, discussed below. Thus, for the above reasons alone, Radovich clearly and unequivocally fails to disclose all elements of the instant claims, and does not anticipate the instant claims.

Although the Examiner appears to consider these features (pencil hardness, processability according to the limitations provided in instant claim 1) to be inherent in Radovich, no evidence or reasons therefor are stated. In relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.

As further noted in the Response file September 5, 2006 to the Office Action dated June 5, 2006, Radovich discloses preparation of the flexible polyurethane foams in which the

coupled polyol is reacted with an organic polyisocyanate in the presence of a blowing agent, a catalyst, and a foam stabilizer. Col. 6, lines 42-45; emphasis added. Radovich extensively discloses these components (blowing agent, catalysts, foam stabilizers, and reaction retarders) in preparing the *foams* disclosed therein. Col. 6, line 53 to Col. 8, line 47; emphasis added. Radovich discloses use of known methods of preparing foams, including in mold-foaming, cold-hardening foams, and block foaming, but is silent as to the preparation of non-foamed polyurethanes suitable for film forming. Col. 8, line 48 to Col. 9, line 14. There is no teaching or disclosure at all of the use of polyurethane foams in the present specification, in contrast to the disclosure of Radovich, and there is no claim to the use of blowing agents, etc. in the instant claims. In view of the difference between the polyurethane foam of Radovich and the claimed urethane-modified polyester resin composition, for application to the preparation of a paint in an exemplary embodiment, and as disclosed and claimed in the instant Specification and claims, Applicants submit that there is no basis for an assertion of inherency in Radovich as to the pencil hardness and processability of the urethane-modified polyester resin composition as claimed.

There is a clear distinction in the *structure* of a composition comprising a blowing agent and prepared using a blowing agent, when compared to a similar composition prepared in the absence of a blowing agent, and therefore the two are not identical as would be apparent to one skilled in the art. Applicants note that Radovich discloses that polyurethane foam is produced by reacting a polyol with an organic polyisocyanate in the presence a blowing agent and a foam stabilizer. However, the invention as claimed in instant Claim 1 has the feature that the urethane-modified polyester is produced by reacting the polyester resin with the isocyanate in the *absence* of the blowing agent and the foam stabilizer. It would not, however, be apparent that the absence of a blowing agent and any other additive present in the polyurethane foam composition of Radovich, present to maintain the foamed structure, would necessarily provide the dramatically different and desirable properties of pencil hardness and processability in the urethane-modified polyester resin composition as claimed in the instant claims, that would make such a urethane-modified polyester resin composition suitable for use in a paint as exemplified in the instant Specification. Such an assertion of equivalent hardness

and processability for the compositions of Radovich and the claimed composition would be counterintuitive to one skilled in the art. Radovich therefore fails to teach or disclose that a flexible polyurethane foam can be prepared in the absence of the blowing agent, catalyst, or foam stabilizer, and fails to teach or disclose the preparation of polyurethane-polyols using any non-foam forming polymerization methods or having a structure other than that of a foam.

Furthermore, Radovich discloses the application of the foams to producing upholstery material, cushioning, carpet underlay, and mattresses. Col. 9, lines 15-17. One skilled in the art will appreciate that such applications are clearly not based on the same or even similar properties as would be present in a film as used in a paint coating. A paint coating, as disclosed in the instant Specification, has little or no lofted structure, while a foam such as that disclosed in Radovich and as exemplified in Radovich for use in upholstery is a lofted structure possessing gas pockets with either closed-cell or open-cell structure, directly attributable to the use of blowing agents which would be antithetical to the intended purpose of a paint as disclosed and exemplified in the instant Specification and Examples which present a hardened surface. A polyurethane foam prepared (as in Radovich) to have significantly enhanced load bearing properties is therefore not identical in structure or properties to a urethane-modified polyester resin composition useful for preparing films, and therefore a foam having increased load bearing properties will not have a hardness or processability that is identical to that of a urethane-modified polyester resin composition prepared and optimized for film forming characteristics.

Finally, as to the Examiner's statement that it is unclear that the pencil hardness and/or processability are due to the properties of the urethane-modified polyester resin composition as claimed in the instant claims, Applicants respectfully assert that the paint coatings as exemplified in the Specification in Examples 1-4 each possess the requisite pencil hardness and processability as claimed at a consistent proportion of pigment to resin (20:60 on a weight basis, respectively – See Table 1), where the only differences among these examples are the variations in the urethane-modified polyester composition constituent. In addition, Comparative Example 2, which does not have the same processability as Examples 1-4 but has the same hardness, has a higher proportion of pigment relative to the resin component

(20:25 on a weight basis, respectively – see Table 3), and therefore any advantage in hardness and/or processability of the instant Examples 1-4 is conveyed to a paint film for testing by the urethane-modified polyester resin composition itself as disclosed in the instant examples and as claimed in the instant claims, and not by the addition of additives.

Radovich thus fails to disclose a urethane-modified polyester resin composition having the claimed properties of pencil hardness and processability, fails to disclose or teach that the polyurethane foam as provided by Radovich would inherently possess the pencil hardness or processability of amended instant claim 1, and therefore fails to disclose all elements of the instant claims. Thus, for at least the above reasons, Radovich fails to disclose all elements of the instant claims, and does not anticipate the instant claims. Accordingly, reconsideration and allowance are respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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